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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,435	06/14/2002	Rudolf Marx	047.0059	7570

7590

07/31/2003

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EXAMINER

FEELY, MICHAEL J

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 07/31/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/049,435

Applicant(s)

MARX ET AL.

Examiner

Michael J Feely

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 June 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 6 is/are rejected.
- 7) ☒ Claim(s) 2-5 and 7-12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.                      6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Claim Objections*

2. Claims 7-12 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend on another multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 7-12 have not been further treated on the merits.

### *Claim Rejections - 35 USC § 102/103*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 and 6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Murai et al. (US Pat. No. 5,770,301).

Regarding claims 1 and 6, Murai et al. disclose *(1)* a workpiece with a substrate of ceramic, metal, or polymer (Abstract; column 3, line 55 through column 4, line 13), the substrate having a surface which is conditioned to form a stable connection with a polymer (column 5,

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lines 9-16) and which is provided with a silica layer (Abstract; column 6, line 58 through column 7, line 7) and, on top of this, with a silane coupling agent (Abstract; column 8, lines 36-43), and on top of the silane coupling agent, a preserving protective layer (Abstract; column 7, lines 27-41) which is sterile and/or can be sterilized after polymerization (column 13, lines 13-25); (6) wherein the sterile and/or sterilizable preserving protective layer has a thickness of  $< 100 \mu\text{m}$  (column 10, lines 6-16).

The claim language, "is provided as the activatable first component of a multi-component adhesive which at the time of use is formed by addition of at least one further adhesive component," implies features of the workpiece that are present in the future. The preserving protective layer is present; however, the multi-component adhesive is not necessarily present in the instant article claim. Murai et al. do not teach a multi-component adhesive, but based on the current claim language, this feature is not required in the instant invention.

In addition, the language "activatable" is broad, and relatively nondescript. Just about any material *can be activated* by a surface treatment of some kind, i.e. performed by cleaning, chemical treatment, etching, corona treatment, or plasma treatment. Therefore, the preserving protective layer set forth by Murai et al. would have inherently met the *activatable* limitation.

Regarding the sterile condition of the substrate, the silica layer, and the silane coupling agent, Murai et al. discloses that the laminate can be used in packaging applications, including microwave-sterilization (column 13, line 16). Although Murai et al. do not explicitly disclose that each of the layers is sterile, a microwave-sterilization process would have resulted in a sterile overall laminate material. Where the laminate material, as a whole, is sterile, the individual layers would have inherently been sterile as well.

***Allowable Subject Matter***

6. Claims 2-5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter:

Regarding claims 2-5, Murai et al. fail to teach or suggest the embodiments of the instant invention, wherein the preserving protective layer are made of the following specific materials:

2) polymethyl methacrylate, 3) BisGMA, 4) epoxy resin, and 5) phenolic resin. Murai et al. teach the use the following materials as the preserving protective layer: vinylidene chlorine-based copolymers, ethylene-vinyl alcohol copolymers, polyamide series polymers, polyvinyl alcohol series polymers, polyacrylonitrile series polymers, and urethane polymers.

***References from the International Search Report***

8. The international search report cited the following reference as Y-references: US Pat. No. 4,364,731 and US Pat. No. 5,437,937. These references have been considered; however, they have not been applied as prior art for the reasons set forth in the International Written Opinion.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J Feely whose telephone number is 703-305-0268. The examiner can normally be reached on M-F 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Michael J. Feely  
July 24, 2003

A handwritten signature in black ink, reading "Robert A. Dawson". The signature is fluid and cursive, with the first name "Robert" and last name "Dawson" clearly legible, and a middle initial "A." in between.

Robert Dawson  
Supervisory Patent Examiner  
Technology Center 1700